

Notice of Allowability

Application No.

10/070,329

Applicant(s)

IKEMOTO ET AL.

Examiner

Zachary C. Tucker

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 14 December 2004.
2. ☒ The allowed claim(s) is/are 8, 10-12, 14 AND 15.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 5Mar02, 4Apr03
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1624

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

This application is in condition for allowance except for the presence of claims 1-7 and 16-30 to inventions non-elected without traverse in the 13 April 2004 reply to the finding of Lack of Unity of Invention. The finding of Lack of Unity of Invention was mailed 16 March 2004.

Accordingly, claims 1-7 and 16-30 have been cancelled.

IN THE CLAIMS –

Claims 1-7 and 16-30 have been cancelled.

end of amendment

Response to Amendment

As requested in the correspondence from applicants filed 14 December 2004, claims 8 and 12 have been amended.

Status of Claim Rejections - 35 USC § 112

In the previous Office action, claims 8, 10-12, 14 and 15 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness of multiple and compounded "optionally substituted" recitations, and also for recitations of "heterocyclic group" without any definition of the size of the ring, character and number of heteroatoms.

In view of the amendment filed 14 December 2004, the rejections under this statute are hereby withdrawn.

The heterocyclic rings are now sufficiently described, and the optional substituents are all now clear and definite.

Status of Claim Rejections - 35 USC § 102

In the previous Office action, claims 8, 10, 12 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by Proctor and Thomson, "Azabenzocycloheptenones. Part II. Dieckmann Cyclisation of Arylamino-esters" Journal of the Chemical Society, pages 2312-2314 (1957).

In view of the amendment to claims 8 and 12, which now does not permit for "Y" to be a formyl group substituted with hydroxy at the hydrogen atom, the rejection based on Proctor and Thomson is hereby withdrawn.

Art Unit: 1624

In the previous Office action, claims 8, 10-12, 14 and 15 were rejected under 35 U.S.C. 102(b) as being anticipated by Brauholtz and Mann, "The Structure and Properties of Certain Polycyclic Indolo- and Quinolono-derivatives. Part XI. Derivatives of 4:5:6:7-Tetrahydro-1-methyl-4-oxo-2:3-benzazepine" Journal of the Chemical Society, pages 3377-3386 (1958).

In view of the amendment to claims 8 and 12, which now does not permit for "Y" to be a formyl group substituted with hydroxy at the hydrogen atom, the rejection based on Brauholtz and Mann is hereby withdrawn.

In the previous Office action, claims 8, 10-12, 14 and 15 were rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/22589 (Watson et al).

In view of the amendment to claims 8 and 12, which now does not permit for "Y" to be a formyl group substituted with amino at the hydrogen atom, the rejection based on Watson et al is hereby withdrawn.

Allowable Subject Matter

Claims 8, 10-12, 14 and 15 are allowed.

The following is an examiner's statement of reasons for allowance:

All claim rejections have been withdrawn.

No issue of indefiniteness or lack of enablement with regard to the instantly claimed compounds remains.

The closest prior art has been cited in this application previously in rejections under 35 U.S.C. 102 and 103, in the Office actions mailed 28 April 2004 and 14

Art Unit: 1624

September 2004. Compounds of the invention are novel and unobvious over this closest prior art by virtue of the substituent "Y," which is required to be an acyl group of the formula $-(CO)R^{20}$ where R^{20} is hydrogen or the alkyl, alkenyl, cycloalkyl, aryl or phenylalkyl which are defined in the independent claims, 8 and 12.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Information Disclosure Statement

Applicants' correspondence filed 14 December 2004 includes a request for the examiner to consider the references submitted in Information Disclosure Statements filed 5 March 2002 and 4 April 2003. The signed and initialed forms PTO-1449 associated with these Information Disclosure Statements were mailed 16 March 2004 with the finding of Lack of Unity of Invention.

Copies of these signed and initialed forms PTO-1449 are included with this Notice of Allowability. Item B15 on the PTO-1449 dated 4 April 2003 has not been considered because it is not dated, and includes no identifying information.

Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

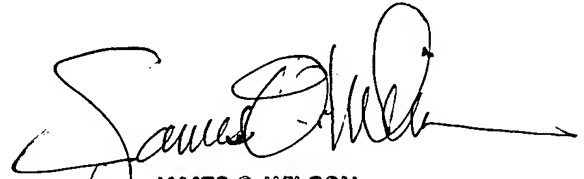
Or you can fax them to the Office of Patent Publications at 703-308-5083, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312;

Art Unit: 1624

information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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A handwritten signature in black ink, appearing to be "Zalich", followed by a horizontal line.A handwritten signature in black ink, appearing to be "James O. Wilson", followed by a horizontal line.

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600